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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/674,781	09/30/2003	Christopher K. Karstens	RSW920030085US1	4452
43168 7590 11/21/2007 MARCIA L. DOUBET LAW FIRM PO BOX 422859 KISSIMMEE, FL 34742			EXAMINER BLAIR, DOUGLAS B	
			ART UNIT 2142	PAPER NUMBER
			NOTIFICATION DATE 11/21/2007	DELIVERY MODE ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

mld@mindspring.com

Office Action Summary

Application No.

10/674,781

Applicant(s)

KARSTENS, CHRISTOPHER K.

Examiner

Douglas B. Blair

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 September 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-40 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-40 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

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DETAILED ACTION

Response to Amendment

Claims 1-40 are currently pending in this application. The objection to the specification for not providing antecedent basis has been withdrawn in view of the applicant's claim amendment.

Response to Arguments

Applicant's arguments filed 9/7/2007 with respect to the 35 USC section 101 rejection have been fully considered but they are not persuasive. The applicant's amendment makes it clearer that the IM client is software because it is "operable" on a computing device. The applicant is not positively claiming the computing device as part of the system, only the client running on the computing device.

Applicant's arguments, with respect to the Malik reference have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of The AOL Buddy Lists FAQ from 2000. Though Malik may delete expired contacts, the concept of not deleting a user from a list of is not novel as AOL buddy lists have been performing such functionality since at least the year 2000.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

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Claims 20-30 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claims 20-31 are directed towards software per se and therefore are not part of a statutory class of invention.

Claim 20 is directed towards a system comprising an IM client, means for determining, and means for omitting. The IM client is disclosed as the actual software user interface for the IM system on page 9 of the applicant's specification. The claimed means are interpreted as the software instructions and code for carrying out the claimed functions. There is no suggestion in the specification that there are distinct hardware means for carrying out each of the claimed functions. This interpretation is consistent with the description on pages 35 and 36 of the applicant's specification.

Claims 21-30 do not feature any further limitations directing the claimed system towards statutory subject matter.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-3, 8-15, 17, 19-21, 24-32, and 35-40 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Number 7,096,255 to Malik in view of the AOL Buddy List FAQ from the year 2000.

As to claim 1, Malik teaches a method of managing user information in an IM system, comprising the steps of: determining, for an IM client that is operably connected to the IM system, whether any of the plurality of users remembered by the IM client should be treated as expired (col. 7, lines 44-60); and for each one of the plurality of users for whom the determining step determines that the user is to be treated as expired, omitting this user when performing selected IM management functions of the IM system by automatically remembering that this user is to be treated as expired (col. 8, lines 23-40); however Malik does not explicitly teach not deleting the user from the plurality of users remembered by the IM client.

The AOL FAQ on page 3 describes dimming buddies screen names from a list after they have been idle for a certain period of time. The option setting to dim buddies in the buddy list after they have been idle for five minutes is considered an expiration.

It would have been obvious to one of ordinary skill in the Computer Networking art at the time of the applicant's invention to combine the teachings of Malik regarding the management of users in an instant messaging environment with the teachings of the AOL FAQ regarding the treatment of expired users because an IM user may want to keep information on an expired contact for future reference. Combining the two references would produce a predictable result since both references are just alternative embodiments of the same technology.

As to claim 2, Malik teaches the method of claim 1, wherein the omitting step omits each one the determined users when performing presence determination (col. 9, lines 31-45).

As to claim 3, Malik teaches the method of claim 1, wherein the determining step further comprises the step of using expiration criteria selected by a user of the IM client (col. 7, line 61-col. 8, line 12).

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As to claim 8, Malik teaches the method of claim 1, wherein the determining step further comprises the step of selecting, by a user of the IM client, at least one of the users that will then be automatically treated as currently expired (col. 9, lines 15-17, if the user confirms the removal, the contact will be treated as currently expired).

As to claim 9, Malik teaches the method of claim 1, wherein the determining step is performed by analyzing expiration information for each presently unexpired user upon occurrence of a configured interval (col. 8, lines 33-40).

As to claim 10, Malik teaches the method of claim 1, wherein the determining an omitting steps are also performed for user groups remembered by the IM client (col. 7, lines 44-60).

As to claim 11, Malik teaches the method of claim 1, wherein the determining step uses default expiration criteria and further comprising the step of enabling a user of the IM client to selectively override the default expiration criteria (col. 8, lines 41-57).

As to claim 12, Malik teaches the method of claim 1, further comprising the steps of: receiving an inbound message from a particular user who is being treated as expired (col. 8, lines 7-12, the beginning/ending of a chat sessions could be to or from an expired user); and automatically treating the particular user as no longer expired, responsive to the receiving step (col. 8, lines 7-12, the user is added to the temporary contact list, thus no long expired).

As to claim 13, it is rejected for the same reasoning as claim 12.

As to claim 15, Malik teaches the method of claim 1, wherein the users remembered by the IM client are those users having entries in an address book used by the IM client (col. 6, lines 2-10, the roster is considered an address book).

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As to claim 17, Malik teaches a method of managing user information in an IM system, comprising the steps of: determining, for an IM client that is operably connected to the IM system, whether any of the plurality of users remembered by the IM client should be treated as expired but not deleted from the plurality of remembered users (col. 7, lines 44-60); and for each one of the plurality of users for whom the determining step determines that the user is to be treated as expired, providing a different visual representation for this user as contrasted to the remembered users who are not to be treated as expired, when displaying an IM client display to a user of the IM client (col. 8, lines 41-57, the prompt is considered a different visual representation); however Malik does not explicitly teach displaying contrasted representations of users at the same time.

The AOL FAQ teaches displaying contrasted representations of users simultaneously as dimmed buddies represent idle screen names. It would have been obvious to combine Malik and the AOL FAQ for reasons discussed in the rejection of claim 1.

As to claim 14, it is rejected for the same reasoning as claim 17.

As to claim 19, Malik teaches the method of claim 17, wherein the different visual representation comprises automatically moving, to a selected location that is distinct from the IM client display, the names or nicknames of the remembered users who are to be treated as expired when displaying the IM client display to the IM client user (col. 8, lines 41-57).

As to claims 20-21, 24, and 26-30, they feature a system which implements the method of claims 1-2, 8, 10, and 12-15, respectively, and are therefore rejected for the same reasons as claims 1-2, 8, 10, and 12-15, respectively.

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As to claim 25, Malik teaches the system of claim 20, wherein the means for determining is performed upon occurrence of a scheduled action that analyzes expiration information for each presently-unexpired user (col. 8, lines 33-40, the monitoring is considered a scheduled action).

As to claims 31-32, 35, and 37-40, they feature program code for implementing the method of claims 1-2, 8, 10-11, and 14-15, respectively, and are therefore rejected for the same reasons as claims 1-2, 8, 10-11, and 14-15, respectively.

As to claim 36, Malik teaches the system of claim 31, wherein the computer-readable program code means for determining further comprises: computer-readable program code means for scheduling an expiration action for each of one or more of the remembered users (col. 7, lines 44-60); and computer-readable program code means for treating each of the remembered users upon executing the scheduled expiration action for that remembered user (col. 8, lines 41-57, the prompt action is performed for each of the users).

Claims 4-7, 22-23, and 33-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Number 7,096,255 to Malik in view of the AOL Buddy List FAQ from the year 2000 in further view of U.S. Patent Application Publication Number 2003/0065721 to Roskind.

As to claim 4, Malik teaches the method of claim 1 including the step of comparing a first date when a particular user was added to a second date selected by a user of the IM client (col. 8, lines 41-56); however Malik does not teach a step of comparing a first date when an instant message last arrived from a particular user to a second date selected by a user of the IM client.

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Roskind teaches a step of comparing first data when an instant message last arrived from a particular user to a second date selected by a user of the IM client (paragraph 99).

It would have been obvious to one of ordinary skill in the Computer Networking art at the time of the invention to combine the teachings of Malik regarding determining whether a contact has expired with the teachings of Roskind regarding determining an expiration based on the date a last instant message was received because Malik suggests that many variations and modifications can be made to the invention (col. 10, lines 15-16) and the implementation taught by Roskind preserves communications with the most active contacts that a user may have business with.

As to claim 5, it is rejected for the same reason as claim 4 since a difference between dates is the same thing as a specified length of time.

As to claims 6-7, Roskind applies the same way to messages both sent and received (see paragraph 99).

As to claims 22-23 and 33-34, they feature the same limitations as claims 4-7 and are rejected for the same reasons as claims 4-7.

Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Number 7,096,255 to Malik in view of the AOL Buddy List FAQ from the year 2000 in further view of U.S. Patent Application Publication Number 2003/0110044 to Nix et al.

As to claim 16, the Malik-AOL FAQ combination teaches the substance of claim 16 for the same reasons pointed out in the rejection of claim 17 above; however the Malik-AOL FAQ combination does not explicitly teach charging a fee for carrying out the evaluating and providing steps.

Nix teaches charging fees for various services in a network including service related to instant messaging (paragraph 4).

It would have been obvious to one of ordinary skill in the Computer networking art at the time of the invention to combine the teachings of the Malik-AOL combination regarding determining the presence of users in an IM system with the teachings of Nix regarding charging for such services because the Malik invention states that it can be integrated with billing applications (col. 7, lines 3-21).

Claim 18 rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Number 7,096,255 to Malik in view of the AOL Buddy List FAQ from the year 2000 in further view of U.S. Pant Application Publication Number 2005/0044143 to Zimmermann et al.

As to claim 18, the Malik-AOL combination teaches the method of claim 17, however the Malik-AOL combination does not explicitly teach the use of italicized font.

Zimmermann teaches the use of italicized font to indicate presence information in an instant messaging system (paragraph 51).

It would have been obvious to one of ordinary skill in the Computer Networking art at the time of the invention to combine the teachings of the Malik-AOL combination regarding determining whether a contact has expired with the teachings of Zimmermann regarding indicating presence information with italics because italics provides an easy way to indicate differences between entities defined by text, such as entities in a buddy list.

Claim 18 rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Number 7,096,255 to Malik in view of the AOL Buddy List FAQ from the year 2000 in further view of U.S. Pant Application Publication Number 2004/0172455 to Green et al.

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As to claim 18, the Malik-AOL combination teaches the method of claim 17, however the Malik-AOL combination does not explicitly teach the use of italicized font.

Green teaches the use of italicized font to indicate presence information in an instant messaging system (paragraph 73).

It would have been obvious to one of ordinary skill in the Computer Networking art at the time of the invention to combine the teachings of the Malik-AOL combination regarding determining whether a contact has expired with the teachings of Green regarding indicating presence information with italics because italics provides an easy way to indicate differences between entities defined by text, such as entities in a buddy list.

Claim 18 rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Number 7,096,255 to Malik in view of the AOL Buddy List FAQ from the year 2000.

As to claim 18, the Malik-AOL combination teaches the method of claim 17, however the Malik-AOL combination does not explicitly teach the use of italicized font.

Official notice is taken that the use of italics was well known at the time of the applicant's invention. The applicant did not traverse the official notice taken so therefore this limitation will be viewed as admitted prior art (See MPEP section 2144.03(c)).

It would have been obvious to one of ordinary skill in the Computer Networking art at the time of the invention to combine the teachings of the Malik-AOL combination regarding determining whether a contact has expired with the use of italics because italics provides an easy way to indicate differences between entities defined by text, such as entities in a buddy list.

Claim 18 has been rejected multiple times because of the likelihood that the applicant may be able to file an affidavit or declaration (See MPEP section 706.02(I)(C)).

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Douglas B. Blair whose telephone number is (571) 272-3893.

The examiner can normally be reached on 9:00am-5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Caldwell can be reached on (571) 272-3868. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Douglas Blair

DBB

ANDREW CALDWELL
SUPERVISORY PATENT EXAMINER